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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,453	08/03/2001	Shridhar P. Joshi	47079-00064USP1	1760

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SUITE 2600  
CHICAGO, IL 60606

EXAMINER

CAPRON, AARON J

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 08/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/922,453

Applicant(s)

JOSHI ET AL.

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 17-21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 9-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This is a response to the Amendment received on June 27, 2003, in which claims 17 and 24 were amended. Claims 1-21 and 24-26 are pending.

#### ***Election/Restrictions***

Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 7.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 9-16 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 17-21 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Acres (U.S. Patent No. 6,254,483; hereafter "Acres").

Referring to claim 1, Acres discloses a method of operating a gaming machine, comprising monitoring a number of wager inputs from players of the gaming machine (6:44-50); and altering a visual motif of the gaming machine in response to the number being a certain value (abstract, 1:61-65 and 3:15-20).

Referring to claim 2, Acres discloses includes monitoring wager inputs over a period of time (6:14-19) and while a variety of different visual motifs are being displayed, and determining which of the variety of different visual motifs is a favorite motif, the favorite motif having a largest number of wager inputs as compared to other ones of the variety of visual different visual, the certain value is the number of wager inputs, the altering includes displaying the motif on the machine (6:14-29).

Referring to claims 3-4, Acres discloses the certain value is a predetermined value such that the step of altering occurs at any predetermined frequency (3:16-20 and 6:13-50).

Referring to claim 5, Acres discloses the step of altering background elements (abstract, 1:61-65 and 3:15-20).

Referring to claims 6-8, Acres discloses the background visual elements include a series of cyclical motifs; the step of altering includes consecutively switching between ones of the series of cyclical motifs (Figures 4 and 5). The time variables can relate to a specific time of the day, the week or the year (6:20-29).

Referring to claim 17, Acres discloses a method of operating a gaming machine, comprising storing a plurality of data sets for producing a plurality of different types of visual motifs on a display of the gaming machine (6:4-12); displaying a first visual motif on a display,

discontinuing the first visual motif and displaying a second visual motif on the display based upon use of the gaming machine (abstract and 6:13-62).

Referring to claims 18-19, Acres discloses sequentially displaying additional different types of visual motifs (Figures 4 and 5).

Referring to claim 20, Acres discloses the step of displaying the second one occurs after a predetermined number of plays by the players (6:40-50)

Referring to claim 21, Acres discloses the step of displaying the second one occurs after determining a favorite visual motif of a variety of visual motifs to be displayed by monitoring inputs from the players (6:14-19).

Claims 24-26 correspond in scope to a gaming machine set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above.

### ***Response to Arguments***

Applicant's arguments filed June 27, 2003, have been fully considered but they are not persuasive.

Applicant argues that Acres does not disclose monitoring a number of wager inputs from players of the game machine. However, Acres states that a triggering event can include the rate at which a player plays (6:41-44) and further insinuates that the gaming machine is monitored with respect to the level of money wagered on the game for that particular gaming machine (6:44-50 and claim 15). The rate of money wagered is the number of wager inputs over time. Further, in the alternative, the claim language fails to limit in a manner that would exclude the

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level of money wagered on the entire system by a plurality of players (6:14-19, 6:40-50 and claims 7-8). Therefore the claimed invention fails to preclude Acres's gaming system.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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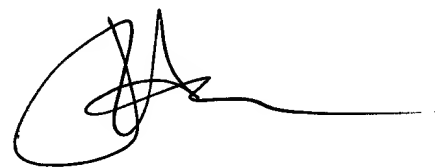
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520.

The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line extending to the right.

**JESSICA HARRISON  
PRIMARY EXAMINER**